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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/483,666	01/14/2000	Robert D. Wilson	BL01134-013	8672

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EXAMINER

COLBERT, ELLA

ART UNIT PAPER NUMBER

3624

DATE MAILED: 12/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/483,666

**Applicant(s)**

WILSON, ROBERT D.

**Examiner**

Ella Colbert

**Art Unit**

3624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 13 October 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

1. Claims 1-20 are pending. Claims 1-4 have been amended in this communication filed 10/13/05 entered as Response After-Non Final Action.

#### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over (US 4,890,228) Longfield in view of "1040-ES Estimated Tax for Individuals 1998", hereafter "1040-ES".

With respect to claim 1, Longfield teaches, A system for providing a loan to a taxpayer prior to the end of the current tax year, comprising: historical income tax refund data for said taxpayer, said historical income tax refund data comprising income tax refund amount data for at least one year prior to the current year and in a computer (col. 2, lines 14-25); year-to-date income data for the current year, for said taxpayer, wherein said date is prior to the end of the current tax year and said year-to-date income data is in said computer (col. 2, lines 26-41 and col. 3, lines 40-45); a process in said computer for processing said historical income tax refund data, said year-to-date income data, and said year-to-date expense data to determine an estimated income tax refund amount for said taxpayer for said current tax year (col. 2, line 60-col. 3, line 12); a loan provided to said taxpayer prior to the end of said current tax year in an amount based

on said estimated income tax refund amount for said current tax year for said taxpayer as determined by said computer (col. 4, lines 3-18); and an income tax refund for said current tax year, wherein said income tax refund is based on a tax return prepared using actual income and expense data and filed after said current tax year for said taxpayer and is applied to the balance of said loan based on said estimated income tax refund (col. 4, line 3-col. 5, line 23). Longfield failed to teach, year-to-date expense data for the current year, for said taxpayer, wherein said date is prior to the end of the tax current year and said year-to-date expense data is in said computer. "1040-ES" teaches year-to-date expense data for the current year, for said taxpayer, wherein said date is prior to the end of the tax current year and said year-to-date expense data is in said computer (Page 4-form). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have year-to-date expense data for the current year, for said taxpayer, wherein said date is prior to the end of the current tax year and said year-to-date expense data is in said computer and to modify in Longfield because such a modification would allow Longfield to have keep track of the expense data and to claim it when filing an estimated tax return.

With respect to claim 2, this independent claim is rejected for the similar rationale as given above for claim 1.

With respect to claims 3 and 14, Longfield teaches, present job verification data for said taxpayer, said job verification data in said computer (col. 5, lines 25-49). Longfield did not expressly disclose that the data is present job verification data. However, it would have been obvious to one having ordinary skill in the art at the time

the invention was made to have present job verification data when filing a tax return.

Longfield teaches, a process in said computer for processing said historical income tax refund data and said present job verification data to determine an estimated income tax refund amount for said taxpayer for current tax year (col. 5, lines 47-49 –“a history file”).

This dependent claim is rejected for the similar rationale as given above for claims 1 and 2.

With respect to claim 4, this independent claim is rejected for the similar rationale as given above for claims 1 and 2.

With respect to claim 5, This independent claim is rejected for the similar rationale as given above for claims 1-4.

With respect to claims 6, 9, and 12, Longfield teaches, The system of claim 1 wherein said historical income tax refund data is determined in accordance with a trend analysis (col. 4, line 56-col. 5, line 3).

With respect to claims 7, 10, and 13, Longfield failed to teach, The system of claim 6 wherein said historical tax refund data comprises the amount of said taxpayer's refund for the previous three years. It would have been obvious to one having ordinary skill in the art to have the historical tax refund data comprise the amount of the taxpayer's refund for the previous three years and to modify in Longfield because such a modification would allow Longfield when filing an amended or adjusted income tax refund to go back to the previous three years or to have an average of the previous three years when filing an estimated income tax return.

With respect to claims 8, 11, and 15, Longfield failed to teach, The system of claim 1 wherein said year to date income information for the current year comprises income data for the first three quarters of the year. "1040-ES" teaches, said year to date income information for the current year comprises income data for the first three quarters of the year (page 3 –shows quarters of payment). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the year to date income information for the current year comprise income data for the first three quarters of the year and to modify in Longfield because such a modification would allow Longfield to have an average of the income information for the current year for the first three quarters when estimating the tax refund on a tax return.

With respect to claims 16 and 20, Longfield failed to teach, The system of claim 4 wherein said income information for the current year is extrapolated based on said taxpayer's income from prior years. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the income information for the current year is extrapolated based on said taxpayer's income from prior years and to modify in Longfield because such a modification would allow Longfield to have a trend analysis for establishing tax vouchers and the tracking of a depositor's patterns.

With respect to claim 17, Longfield failed to teach, The system of claim 4 wherein said estimated income tax refund amount for said taxpayer is determined in accordance with said taxpayer's withholding rate and taxing authority rates.

"1040-ES" teaches, The system of claim 4 wherein said estimated income tax refund amount for said taxpayer is determined in accordance with said taxpayer's

withholding rate and taxing authority rates (page 2 and page 4). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have an estimated income tax refund amount for said taxpayer determined in accordance with said taxpayer's withholding rate and taxing authority rates and to modify in Longfield because such a modification would allow Longfield to have a general estimate of the amount of taxes owed according to a tax chart for withholding tax rates and the tax rate of the state where he lives.

With respect to claim 18, this dependent claim is rejected for the similar rationale as given above for claims 6, 9, and 12.

With respect to claim 19, Longfield teaches, The method of claim 5 wherein estimating said taxpayer's income tax refund amount comprises estimating said taxpayer's income for the current year (col. 3, lines 29-59).

### ***Response to Arguments***

4. Applicant's arguments filed 10/13/05 have been fully considered but they are not persuasive.

Issue no. 1: Applicant argues: Longfield (1) does not teach or even suggest using historical income tax refund data and year-to-date income data for a date prior to the end of the current year for any purpose at all, (2) estimating a tax refund prior to the current tax year using historical income tax refund data and year-to-date income data for a date prior to the end of the current year, (3) providing a loan prior to the end of a tax year, and (4) Longfield does not provide the teachings asserted in the Office Action and therefore, cannot be combined with 1040-ES to support the claim

rejections has been considered but is not persuasive. Response: (1) It is interpreted that Longfield teaches using historical income tax refund data and year-to-date income data for a date prior to the end of the current in col. 2, lines 14-25 – “inputting tax preparer information, taxpayer identification, taxpayer tax return information and refund anticipation loan information” (“refund loan anticipation” is interpreted as the amount of the loan). There would have to be historical income tax refund data for a taxpayer in order to calculate the end result of the amount of estimated income tax refund where the data is prior to the end of the tax current year and applying the balance to the loan based on that estimated (projected) income tax; (2) in response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., “estimating a tax refund prior to the current tax year using historical income tax refund data and year-to-date income data for a date prior to the end of the current year”) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). This claim limitation is not found in the claim limitations as recited. Applicant is respectfully requested to point out the limitation “estimating a tax refund prior to the current tax year using historical income tax refund data and year-to-date income data for a date prior to the end of the current year” in the claims. (3) “Providing a loan prior to the end of a tax year” is interpreted as being disclosed by Longfield in col. 4, lines 3-18-“when all of the required W-2's have been completed the preparer can select which forms are to be transmitted to the processing center” and in col. 4, lines 26-



55 ("a taxpayer obtains a refund loan within one or two days"). (4) Longfield and the reference 1040-ES; "Estimated Tax for individuals" can be combined because Longfield teaches different tax return forms for filing taxes and the 1040-ES disclosed an estimated tax form for individuals for filing taxes.

Issue no. 2: Applicant argues: Longfield does not teach or suggest collecting or using historical income tax refund data and year –to-date income and expense data for a date prior to the end of the current year for the purpose of estimating a tax refund and Longfield does not teach or even suggest estimating a tax refund prior to the end of the current tax year and therefore does not teach or even suggest collecting or using historical income tax refund data and year-to-date income and expense data for a date prior to the end of the current year for the purpose of estimating a tax refund has been considered but is not persuasive. Response: Longfield is interpreted as teaching using historical income tax refund data and year –to-date income and expense data for a date prior to the end of the current year for the purpose of estimating a tax refund, estimating a tax refund prior to the end of the current tax year and using historical income tax refund data and year-to-date income and expense data for a date prior to the end of the current year for the purpose of estimating a tax refund in col. 2, line 60-col. 3, line 12, col. 4, line 3-col. 5, line 23.

Conclusion: In this rejection of claim 1 and others, for example under Section 103 (a) of Title 35 of the United States Code, the Examiner carefully drew up a correspondence between the Applicants' claimed limitations and one or more referenced passages in the Longfield and 1040-ES references, what is well known in

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the art, and what is known to one having ordinary skill in the art (the skilled artisan).

The Examiner is entitled to give claim limitations their broadest reasonable interpretation in light of the Specification (see below):

2111 Claim Interpretation; Broadest Reasonable Interpretation [R-1]

>CLAIMS MUST BE GIVEN THEIR BROADEST REASONABLE INTERPRETATION

During patent examination, the pending claims must be “given the broadest reasonable interpretation consistent with the specification.” Applicant always has the opportunity to amend the claims during prosecution and broad interpretation by the examiner reduces the possibility that the claim, once issued, will be interpreted more broadly than is justified. *In re Prater*, 162 USPQ 541,550-51 (CCPA 1969).<

Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicant is respectfully requested to particularly point out and to claim the novel feature of the invention in the independent claims. Where is this feature claimed in claims 1-5?

It is suggest to add the following in the last claim limitation on page 12, “providing a loan to a taxpayer prior to the end of the current tax year in an amount based on said estimated income tax refund amount for said current tax year for said taxpayer as determined by said computer”.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

#### **Inquiries**

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ella Colbert whose telephone number is 571-272-6741. The examiner can normally be reached on Tuesday-Thursday, 6:30AM-4:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on 571-272-6747. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

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Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).



E. Colbert  
Primary Examiner  
December 12, 2005